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HOFFMAN WARNICK LLC
75 STATE ST
14TH FLOOR
ALBANY, NY 12207

EXAMINER

HICKS, MICHAEL J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN C. GODOY, DANNY R. HAGER and
RUSSELL T. WHITE JR.

Appeal 2009-013111
Application 10/688,097
Technology Center 2100

Before KRISTEN L. DROESCH, DENISE M. POTHIER and
BRUCE R. WINSOR, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

BACKGROUND

The invention relates to a method and system for managing custom data for items that are purchased electronically. Spec. ¶ 0001; Abs.

Independent claim 1 is illustrative and is reproduced below (disputed limitations in *italics*):

1. A method of managing custom data by a computer during an electronic purchase, the method comprising:
 - selecting an item for purchase;
 - determining a set of attributes for the item, wherein the attributes include item-based attributes and purchase-based attributes, wherein each item-based attribute relates to information about the item and each purchase-based attribute relates to information about the electronic purchase and wherein each attribute is associated with at least one value;
 - comparing the set of attributes to a set of keys, wherein each key is generated based on data collected on a custom data form and wherein each key includes an attribute with a corresponding matching value;
 - displaying the custom data form using the computer in the case where the corresponding matching value of an attribute in the set of keys matches the at least one value of each attribute for the item; and*
 - obtaining government regulatory information from a customer that is required to comply with disclosure and reporting requirements for a purchase of chemicals via the custom data form.*

Claims 1-6, 9, 10 and 14-20¹ stand rejected under 35 U.S.C. 103(a) as unpatentable over Nishimura (US 2001/0051904 A1), Christensen (US 2002/0154114 A1) and Breen, Jr. (“Breen”) (US 6,598,027 B1).

Claims 7, 8 and 11-13 stand rejected under 35 U.S.C. 103(a) as unpatentable over Nishimura, Christensen, Breen and Leber (US 2003/0182391 A1).

ISSUE

Did the Examiner err in determining that the combined teachings of Nishimura, Christensen and Breen render obvious the invention of claim 1?

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments in the Appeal Brief presented in response to the Final Office Action. We disagree with Appellants’ conclusions and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken; and (2) the reasons set forth by the Examiner in the Answer in response to the Appeal Brief. However, with respect to the claims argued by Appellants, we highlight and address specific findings and arguments for emphasis as follows. Appellants argue claims 1-20 together as a group. Br. 7-8. We select independent claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(vii).

Appellants first argue that Nishimura does not display a custom form *only when* a match has been made of attribute values. Br. 7 (emphasis added). We are unpersuaded by Appellants’ argument since, as pointed out

¹ The Examiner’s listing of the rejected claims includes claims 11-13. However, the inclusion of claims 11-13 appears to be a typographical error since the limitations of claim 11-13 are not substantively addressed for this ground of rejection. *Compare* Ans. 3 *with* Ans. 7-9 *and with* Ans. 17-19.

by the Examiner (Ans. 19-20), this argument is not commensurate in scope with the claim language. The plain language of claim 1 does not require the display of the custom form *only when* the corresponding matching value matches the at least one value of each attribute for the item. Instead, claim 1 recites “displaying the custom data form using the computer *in the case where* the corresponding matching value of an attribute in the set of keys matches the at least one value of each attribute for the item” In addition, the plain language of claim 1 does not preclude the display of the custom data form also in the case where the corresponding matching value does not match the at least one value of each attribute for the item.

Related to the previous argument, Appellants argue that Nishimura does not determine whether a value of an attribute in a set of keys matches a value of an attribute for the item. Br. 7. Appellants’ argument is unpersuasive because Appellants’ arguments do not cogently explain the supposed errors in the Examiner’s findings. The Examiner finds that Nishimura describes comparing the set of attributes (i.e., product specification values) to a set of keys (i.e., user input specification values) and, wherein each key is generated based on data collected on a custom data form (i.e., specification-confirming screen displays) and includes an attribute with a corresponding matching value and displaying the custom data form in the case where the corresponding matching value of an attribute in the set of keys matches the at least one value of each attribute for the item. Ans. 4, 20 (citing Nishimura ¶ 0078, ll. 11-15; ¶ 0102, ll. 1-7; ¶ 0103, ll.7-9; ¶¶ 0062, 0065, 0075, 0076, 0085, 0086).

Appellants also argue that Nishimura’s description of when a user chooses a product, the user is presented with options for choosing

specifications to customize (the product) is not equivalent to the claimed system which determines whether a user must provide required information as part of the purchase and provides a form to the user for inputting the information. Br. 7-8. Appellants' argument is unpersuasive because it is not commensurate in scope with the claim language. Claim 1 does not recite determining whether a user must provide required information as part of the purchase. Rather, claim 1 recites "determining a set of attributes for an item . . . comparing the set of attributes to a set of keys, wherein each key is generated based on data collected on a custom data form and . . . includes an attribute with a corresponding matching value; displaying the custom data form . . . in the case where the corresponding matching value . . . matches the at least one value of each attribute for the item; and obtaining . . . information from a customer . . . via the custom data form."

Lastly, Appellants argue that the cited references do not disclose that the custom data form obtains government regulatory information from the customer that is required to comply with disclosure and reporting requirements for the purchase of chemicals. Br. 8. Appellants argue that Breen only describes that a user provides information confirming that the customer has the necessary licenses in connection with a purchase. Br. 8 (citing Breen col. 14, ll. 30-40). We are unpersuaded by Appellants' arguments because "government regulatory information from a customer that is required to comply with disclosure and reporting requirements for a purchase of chemicals" is directed to non-functional descriptive material and merely describes the class of information which is obtained from the customer via the custom data form. Accordingly, "government regulatory information from a customer that is required to comply with disclosure and

reporting requirements for a purchase of chemicals” in the context of “information” is not entitled to patentable weight. Appellants also do not appear to contest the Examiner’s finding that the combination of Nishimura, Christensen and Breen teaches obtaining information (i.e., regulatory licensing information) from a customer in connection with a purchase via a custom data form. *See* Ans. 5.

For these reasons, we sustain the Examiner’s rejections of claims 1-20.

DECISION

We AFFIRM the rejection of claims 1-6, 9, 10 and 14-20 under 35 U.S.C. § 103(a) as unpatentable over Nishimura, Christensen and Breen.

We AFFIRM the rejection of claims 7, 8 and 11-13 under 35 U.S.C. § 103(a) as unpatentable over Nishimura, Christensen, Breen and Leber.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

ELD